

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. CONBOY,
PATRICK J. RYAN
and ELFIDO COSS, JR.

Appeal No. 2002-1821
Application 09/207,282

ON BRIEF

Before COHEN, MCQUADE, and BAHR, Administrative Patent Judges.

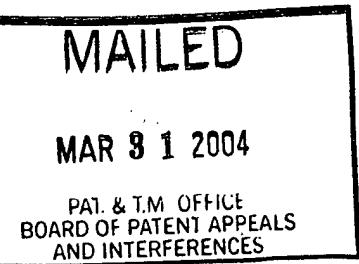
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Michael R. Conboy et al. appeal from the final rejection of claims 1 through 20, all of the claims pending in the application.

THE INVENTION

The invention relates to "the management of multiple types of empty carriers in automated material handling systems"



(specification, page 1). Representative claims 1 and 10 read as follows:

1. An automated material handling system, comprising:
 - a plurality of material carriers including a plurality of empty carriers classified into at least two empty carrier types;
 - at least one stock area, each including a plurality of bins for storing material carriers, wherein each stock area is associated with at least one threshold for each empty carrier type;
 - a control system coupled to a first one of the stock areas for computing an empty percentage for the first stock area for each empty carrier type, the empty percentage for a particular carrier type being the percentage of bins of the first one stock area which contain empty carriers of the particular type; and
 - a transportation system responsive to the control system for selectively moving an empty carrier of a certain empty carrier type between a staging area and the first stock area based on a comparison of the empty percentage for the certain carrier type to the at least one threshold of the first stock area for the certain empty carrier type.
10. A method for managing empty material carriers in an automated material handling system including a plurality of material carriers including empty material carriers and at least one stock area each including bins for storing material carriers, the method comprising:
 - classifying at least the empty material carriers into at least two empty carrier types;
 - associating each of the stock areas with at least one threshold for each carrier type;
 - computing an empty percentage for each empty carrier type for a first one of the stock areas, the empty percentage for a particular empty carrier type being the percentage of bins of the first one stock area which contain empty carriers of the particular type; and
 - selectively moving an empty carrier of a certain empty carrier type between a staging area and the first stock area based on a comparison of the empty percentage for the certain carrier type for the first stock area to the at least one threshold of the first stock area for the certain carrier type.

Appeal No. 2002-1821
Application No. 09/207,282

THE REFERENCES

The references relied on by the examiner to support the final rejection are:

Burney	4,829,445	May 9, 1989
Tau et al. (Tau)	5,751,581	May 12, 1998
Conboy et al. (Conboy)	5,838,566	Nov. 17, 1998

THE REJECTIONS

Claims 1 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Conboy.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Conboy in view of Burney.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Conboy in view of Tau.

Attention is directed to the main and reply briefs (Paper Nos. 17 and 20) and the answer (Paper No. 18) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. Preliminary Matter

On May 7, 2001, the appellants filed a paper styled "TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321 AND DECLARATION UNDER § 1.130" (Paper No. 10). In response (see the advisory action dated May 18, 2001, Paper No. 11), the examiner deemed the

Appeal No. 2002-1821
Application No. 09/207,282

"terminal disclaimer" to be effective under 37 CFR § 1.321 to overcome a double patenting rejection of claims 1 through 9, 19 and 20 based on Conboy which had been set forth in the final rejection (Paper No. 7), but refused to consider the "declaration" in conjunction with the "terminal disclaimer" for the purpose of disqualifying Conboy as prior art under 37 CFR § 1.130 with regard to the 35 U.S.C. § 103(a) rejections on appeal.

The appellants and examiner have devoted substantial portions of the briefs and answer to the 37 CFR § 1.130 "declaration." Although the discussion makes for some very curious reading, it ultimately is of no moment given our decision on the merits of the examiner's § 103(a) rejections. Before leaving this issue, however, it deserves to be noted that the "TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321 AND DECLARATION UNDER § 1.130," while acceptable as a terminal disclaimer, in no way, shape or form constitutes a declaration, let alone a declaration meeting the requirements of 37 CFR § 1.130.

II. The merits

The Conboy patent shares the same ownership with the instant application and lists as its inventive entity two of the three appellants. It also discloses an automated material handling

Appeal No. 2002-1821
Application No. 09/207,282

system and method having much in common with the automated material handling system and method recited in the appealed claims. Indeed, the respective disclosures, filing dates¹ and inventive entities of the patent and the application fairly imply that the subject matter on appeal is a subsequent refinement of the subject matter disclosed and claimed in the patent.² As conceded by the examiner (see page 11 in the answer), however, the Conboy patent does not meet the limitations in independent claims 1 and 10, and the corresponding limitations in independent claims 19 and 20, relating to the classification of the empty carriers into at least two empty carrier types.

With regard to the 35 U.S.C. § 103(a) rejection of claims 1 through 20 as being unpatentable over Conboy, the examiner deals with the admitted deficiency of Conboy by baldly concluding that it would have been obvious "for Conboy et al. '566 to classify the carriers into a plurality of types because knowing the attributes and features of the carriers assists in determining which carriers to move" (answer, page 11). This conclusion is

¹ The Conboy patent has a filing date of December 10, 1996 and the instant application has a filing date of December 8, 1998.

² This implication flies in the face of the attempt in the instant application to utilize 37 CFR § 1.130 to disqualify the Conboy patent as prior art.

Appeal No. 2002-1821
Application No. 09/207,282

ill founded because the examiner has failed to advance any evidentiary support therefor. Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1, 10, 19 and 20, and dependent claims 2 through 9 and 11 through 18, as being unpatentable over Conboy.

As for the 35 U.S.C. § 103(a) rejections of claims 19 and 20 as being unpatentable over (1) Conboy in view of Burney and (2) Conboy in view of Tau, the examiner concludes that it would have been obvious in view of Burney and Tau, respectively, "for Conboy et al. '566 to use a plurality of carrier types because classifying the carriers into a plurality of types aids in knowing the attributes and features of the carriers thereby assisting in determining which carriers to move" (answer, page 12 and page 13). This conclusion rests on findings that both Burney

Appeal No. 2002-1821
Application No. 09/207,282

and Tau disclose "empty carriers classified into a plurality of carrier types" (answer, page 12). The portions of the Burney and Tau disclosures relied on by the examiner, however, do not support these findings. At best, the specified portions of these references teach or suggest that material handling carriers can be identified via means unique to each carrier or by the process status of the materials carried thereby. There is nothing in these disclosures which would have suggested modifying the automated material handling system disclosed by Conboy so as to meet the particular limitations in claims 19 and 20 relating to the classification of empty carriers into at least two empty carrier types.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 19 and 20 as being unpatentable over Conboy in view of Burney, or the standing 35 U.S.C. § 103(a) rejection of claims 19 and 20 as being unpatentable over Conboy in view of Tau.

SUMMARY

The decision of the examiner to reject claims 1 through 20 is reversed.

Appeal No. 2002-1821
Application No. 09/207,282

REVERSED

Irwin Charles Cohen
IRWIN CHARLES COHEN
Administrative Patent Judge)
)
)
)
)
)
)
John P. McQuade
JOHN P. MCQUADE
Administrative Patent Judge)
)
)
)
)
)
)
)
)
)
)
)
)
)
)
Jennifer D. Bahr
JENNIFER D. BAHR
Administrative Patent Judge)

JPM/kis

Appeal No. 2002-1821
Application No. 09/207,282

ROBERT J. CRAWFORD
CRAWFORD PLLC
1270 NORTHLAND DRIVE
SUITE 390
ST. PAUL, MN 55120